	ed States Patent	UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov			
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/507,145	09/08/2004	Ilaria Meloni	962-PCT-US	9082	
7590 05/17/2006			EXAMINER		
Albert Wai Kit Chan			BABIC, CHRISTOPHER M		
Law Offices of Albert Wai Kit Chan World Plaza Suite 604			ART UNIT	PAPER NUMBER	
141 07 20th Avenue			1637	_	
Whitestone, N	Y 11357		DATE MAILED: 05/17/2006		

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	10/507,145	MELONI ET AL.					
Office Action Summary	Examiner	Art Unit					
	Christopher M. Babic	1637					
The MAILING DATE of this communication app Period for Reply	bears on the cover sheet with the	correspondence address					
 A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 							
Status							
1) Responsive to communication(s) filed on							
	action is non-final.						
3) Since this application is in condition for allowar	nce except for formal matters, pr	osecution as to the merits is					
closed in accordance with the practice under E	Ex parte Quayle, 1935 C.D. 11, 4	53 O.G. 213.					
Disposition of Claims							
4)⊠ Claim(s) <u>1-13</u> is/are pending in the application.							
4a) Of the above claim(s) is/are withdray							
5) Claim(s) is/are allowed.							
6) Claim(s) is/are rejected.							
7) Claim(s) is/are objected to.							
8) Claim(s) <u>1-13</u> are subject to restriction and/or e	election requirement.						
Application Papers							
9) The specification is objected to by the Examine	r.						
10) The drawing(s) filed on is/are: a) acc	10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any objection to the							
Replacement drawing sheet(s) including the correct	ion is required if the drawing(s) is ot	pjected to. See 37 CFR 1.121(d).					
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority under 35 U.S.C. § 119							
12) Acknowledgment is made of a claim for foreign	priority under 35 U.S.C. § 119(a	ı)-(d) or (f).					
a)⊠ All b)⊡ Some * c)⊡ None of:							
1. Certified copies of the priority document							
2. Certified copies of the priority document	•••						
3. Copies of the certified copies of the priority documents have been received in this National Stage							
application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list of the certified copies not received.							
Attachment(s)							
1) ⊠ Notice of References Cited (PTO-892) 4) □ Interview Summary (PTO-413)							
2) D Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail D	Date					
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	5) 🔛 Notice of Informal I 6) 🗌 Other:	Patent Application (PTO-152)					
U.S. Patent and Trademark Office	.,						

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PTO	L-326	(Rev.	7-0	5)

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DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which

are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 2, drawn to a nucleic acid molecule.

Group II, claim(s) 3-6, drawn to a method to detect in a subject at least one

mutation of the gene encoding for the FALC4 protein.

Group III, claim(s) 7 and 8, drawn to a diagnostic kit.

Group IV, claim(s) 9 and 10, drawn to a FACL4 protein.

Group V, claim(s) 11 and 12, drawn to a method to determine the enzymatic activity of FACL4 protein.

Group VI, claim(s) 13, drawn to a diagnostic kit.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

A nucleic acid molecule comprising at least one fragment of the human FACL4 gene that encodes for a functional portion of the FALC4 protein was known in the art at

the time of invention in view of Cao et al. (WO 02/16575; page 15, example 1, for example).

The said product cannot therefore be considered a special technical feature, as lack of unity rules hold that a feature known to a person of ordinary skill in the art makes no advance over the prior art.

This application contains claims directed to the following patentably distinct Restriction Subgroups of the claimed invention. After election of one of the Groups above, Applicant is required to also elect a restriction subgroup. This is not a species election. Applicant will be required to cancel non-elected subject matter upon indication of allowable subject matter.

Each of the polynucleotide sequences comprise a patentably distinct subgroup.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed Subgroup consisting of a **single** primer pair for prosecution on the merits to which the claims shall be restricted.

Applicant is advised that a reply to this requirement must include an identification of the restriction subgroup that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. Should applicant traverse on the ground that the Restriction Subgroups are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the Restriction Subgroups to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised

that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MDE 5/9/06

Christopher Babic Patent Examiner AU 1637

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KENNETH R. HORLICK, PH.D PRIMARY EXAMINER

5/15/06